

REMARKS

Claims 1-6 and 8-15 are pending in the present application. Claim 7 was previously cancelled. Claim 2 is allowed.

Claims 1-5 and 9-15 are directed to certain novel compounds. Claim 6 is directed to a pharmaceutical composition comprising the compounds recited in claim 1 or 2. Claim 8 is directed to a method of using the compounds recited in claim 1 or 2 to treat various indications including pain.

35 U.S.C. §112, First Paragraph - Enablement

The Examiner maintained the rejection of claim 8 under 35 U.S.C. §112, first paragraph, as allegedly not enabled. Specifically, the Examiner states that in order for applicants' September 25, 2006 response to this rejection to be properly considered, the references cited in that response must be submitted.

In response, applicants submit copies of the references.

Accordingly, it is respectfully requested that the rejection of claim 8 under 35 U.S.C. §112, first paragraph for lack of enablement be withdrawn.

35 U.S.C. §112, First Paragraph - Written Description

The Examiner rejected claims 1, 3, 5, 6 and 8-15 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner's rejection is based on the assertion that no support exists for (i) the amendment of the second and third provisos of claim 1 to replace "oxygen" with "hydrogen" for R₄ and (ii) the amendment of claim 1 to add the language "with the further exception of compounds where R₂ is C₁-C₆ alkenyl, when a double bond is between carbon atoms 8 and 7."

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With regard to item (i), applicants annex hereto as Exhibit A a Declaration under 37 C.F.R. §1.132 signed by Dr. Jens Hammer. In the Declaration, Dr. Hammer declares, in relevant part, that (1) he is proficient in both written German and written English; (2) he has reviewed claim 1 as filed in German in PCT/EP2003/006866 ("German claim 1") and claim 1 as it appears in the English translation thereof filed with the U.S. Patent Office as the subject national stage application ("English claim 1"); (3) the second and third provisos of German claim 1 recite the phrase "R₄ Wasserstoff(..)ist" which, when translated into English, means "R₄ is hydrogen"; and (4) the phrase "R₄ is oxygen" constitutes an erroneous translation of the German phrase " R₄ Wasserstoff(..)ist". Accordingly, applicants maintain that description exists for the phrase "R₄ is hydrogen." With regard to item (ii), applicants note that the proviso language added to claim 1 in the September 25, 2006 Amendment has been deleted. Applicants further note that the phrase "C₂-C₆-alkenyl" has also been deleted from claim 1 where it appears with respect to R₂.

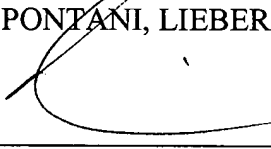
Accordingly, it is respectfully requested that the rejection of claims 1, 3, 5, 6 and 8-15 under 35 U.S.C. §112, first paragraph, be withdrawn.

35 U.S.C. §112, Second Paragraph

Claims 1, 3, 4 and 8 are rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. The Examiner on page 3 of the Office Action offered proposed amendments to certain of the pending claims. These amendments have been made herein. Accordingly, it is respectfully requested that the rejection of claims 1, 3, 4 and 8 under 35 U.S.C. §112, second paragraph, be withdrawn.

If any additional fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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